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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,279	03/24/2000	Gang Lu	2762.2001-002	2501
21005	7590	11/03/2006	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C.			HARRELL, ROBERT B	
530 VIRGINIA ROAD			ART UNIT	
P.O. BOX 9133			PAPER NUMBER	
CONCORD, MA 01742-9133			2142	

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/535,279

Applicant(s)

LU ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 12-40-85 is/are pending in the application.
- 4a) Of the above claim(s) 41-85 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 12-25 and 29-31 is/are allowed.
- 6) ☒ Claim(s) 26-28 and 32-40 are is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>see attached Office Action</u> . |

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1. The applicant's Election (filed 8/25/2004) of claims 1-40 (GROUP I) is again hereby acknowledged. Group II contained claims 41-62 and Group III contained 63-85. Since the applicant has failed to specifically declare the Election as one with or without traverse and since there is/are no rebuttals of the Election by the applicant, the Election is treated as an election without traverse. Therefor, the restriction requirements (mailed 7/21/2004) is/are hereby incorporated in this action in totality as maintained with Group I being claims 1-40, Group II being claims 41-62, and Group III being claims 63-85 and made FINAL.
2. Claims 1-4 and 12-40 remain presented for examination with claims 5-11 cancelled and with claims 41-85 withdrawn from further consideration as non-elected inventions.
3. As indicated in examiner's prior Office Action, the Substitute Specification filed 15 December 2005 is acceptable. However, related application information within the Specification (e.g., see pages 43-44) must be updated with current information (i.e., Now Abandoned, Now United States Patent (number), still pending, exc...).
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The claims are more directed to automatic assignment of sub-network address to a node not recognized by other nodes as being on the sub-network.
5. The applicant should always use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

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7. Claims 26-28 and claims 32-40 are rejected under 35 U.S.C. 102 (e) as being anticipated by Reid (United States Patent Number: US 6,233,616 B1).

8. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

9. Per claim 26, Reid taught a method (e.g., see col. 2 (line 19)) of retrieving a network configuration (e.g., see Abstract) by a first network node (e.g., see figure 1 (101)), the method comprising the steps of:

- a) determining an available local subnet configuration by the first network node (e.g., device 101 of figure 1) in a local subnet (e.g., see figure 1 (102)), the first network node considered by nodes in the local subnet as being external from the subnet (e.g., see col. 3 (lines 58-63)) prior to the portable computer 101 obtaining any dynamic address for any network;
- b) accessing a second network node (e.g., see figure 1 (120)) located outside (e.g., those of LAN 102 in figure 1 per LAN 130)) the local subnet (102) for an available network configuration (e.g., see col. 4 (LINE 37 "207.43.165.41")) from a list (e.g., see figure 4 (TABLE 1)) of network configurations (e.g., see col. 4 (line 12-et seq.)); and
- c) assigning the available network configuration to the first network node (e.g., see col. 4 (line 63-et seq.)).

10. Per claim 27 and claim 28, such was covered in col. 4 as cited above when the device 101 (of figure 1) communicated with the DHCP via router 108 and/or the servers on LAN 130.

11. Per claims 32-40, such do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above in that until device 101 obtains an IP address indicated in col. 4, the device is considered not apart of the current subnet LAN 102 with the DHCP 120 as a processing device for automatically assigning a network configuration to a network node.

12. The rejections, and grounds for rejections, under 35 U.S.C. 102(e) as presented in examiner's prior Office Action mailed 22 February 2006, and prior, are hereby maintained and incorporated in this Office Action by reference.

13. The applicant argued in his 24 August 2006 response by stating in substance that: Reid does not describe or illustrate the portable computing device 101 as a node in the subnet considered by other nodes in the subnet to be external from the subnet. However, as indicated above, the first network node (e.g., device 101 of figure 1) was in a local subnet (e.g., see figure 1 (102)) and the

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first network node was considered by the other nodes in the local subnet as being external from the subnet (e.g., see col. 3 (lines 58-63)) prior to the portable computer 101 having first obtained any dynamic address for any network. Again, there is no temporal order of the steps and/or functions as claimed. Therefore, the portable computer obtaining an address from the router 108 would resided between the first and second steps of claim 26, as an example. That is, the first step of claim 26, as an example, would read on obtaining a configuration from the router 108 while the next step would be obtained from the servers 115 and/or 120 with the final step of claim 26, for example, being performed as outlined above.

14. Pending claims not withdrawn and not mentioned above under 35 U.S.C. 102 stand allowable over the art of record since the art of record fails to teach or remotely suggest posing as a network node having an IP address considered by nodes on the subnet as being external from the subnet in the manner so claimed.

15. This application contains claims 41-85 drawn to an invention nonelected without traverse in the reply filed on filed 8/25/2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

20. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

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A handwritten signature in black ink, appearing to read 'R. B. Harrell', written in a cursive style.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142